

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-25 have been rejected in the Office Action. In the proposed amendments herein, claims 1-3, 6, 7, 9-11, 13-19, and 21-15 have been amended, no new claims have been added, and claims 8 and 20 have been canceled. Accordingly, claims 1-7, 9-19, and 21-25 are pending upon entry of the proposed amendments. Claims 1-7, 9-19, and 21-25 are believed to be in condition for allowance and such favorable action is respectfully requested.

Amendments to the Claims

Amendments to claims 1-3, 6, 7, 9-11, 13-19, and 21-15 have been proposed herein. Care has been exercised to avoid the introduction of new matter. Support for amendments to independent claims 1 and 13 may be found in the Specification, for example, at ¶¶ [0026], [0033], [0040], [0054], [0055], [0059], [0060], and [0062].

Rejections based on 35 U.S.C. § 101

The Office Action rejected claims 13-25 under 35 U.S.C. § 101, indicating that the claims are directed towards non-statutory subject matter. In particular, page 10 of the Office Action indicates that the claims require a hardware component to meet the statutory requirements of 101. To prevent further delay in prosecution of the present application, claims 13-19 and 21-25 have been amended herein to recite one or more computer-storage media in compliance with the suggested change in the Office Action. As such, Applicants respectfully request withdrawal of the rejections of the claims under 35 U.S.C. § 101.

Rejections based on 35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP § 2131.

Claims 1-5 and 8-10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,236,398 to Kojima et al. (“Kojima”). As Kojima fails to describe, either expressly or inherently, each and every element recited in the claims as amended herein, Applicants respectfully traverse this rejection, as hereinafter set forth.

Referring initially to independent claim 1, as amended herein, a method for organizing and displaying items for a user interface is recited. The method includes displaying three-dimensional items that represent user information (e.g., items and files associated with a computer) around a perimeter. The perimeter is of a given geometric shape and forms a portion of a closed area. The three-dimensional items are positioned along the perimeter and are capable of being rotated around the perimeter. The three-dimensional items include a focus item and one or more additional items. The method includes receiving an item selection signal indicative of a user selection of a selected item from the one or more additional items by a user positioning a cursor over the selected item using the pointing device. Based on the item selection signal, the three-dimensional items are rotated around the perimeter causing the selected item be displayed as a new focus item. Accordingly, the method provides a compelling and dynamic way to present items associated with a computer to a user.

In contrast to the invention of claim 1, Kojima is directed to a media selecting device that allows a user to easily select an icon representing media from a plurality of icons. *See, e.g., Kojima*, Abstract; col. 2, line 53 – col. 3, line 16. In Kojima, icons are displayed in a virtual space and may be selected using the media selecting device, which includes a rotary disc type knob that can be turned in both directions to change the displaying order of the icons. *See, e.g., id.*, Abstract; col. 2, lines 55-67. A user may select an icon using the media selecting device by turning the rotary knob to a position that corresponds with the icon the user wishes to select such that the user does not need to position a cursor over the icon on the screen. *See, e.g., id.*, Abstract, col. 3, lines 9-13; col. 10, lines 44-49.

Although the invention of claim 1 and Kojima both relate to the display of items in a virtual or three-dimension space, there are significant differences between the two approaches with respect to how items are rotated and selected. In particular, Kojima employs a rotary disc type knob to rotate the view of items and to select an item, while the invention of claim 1 is not limited to such a specialty device, but instead employs a pointing device (e.g., a mouse) and corresponding cursor commonly found in computing environments. As such, Kojima fails to describe, either expressly or inherently, multiple elements of claim 1. For instance, Kojima fails to describe “receiving an item selection signal indicative of a user selection of a selected item from the one or more additional items by a user positioning a cursor over the selected item using the pointing device; and based on the item selection signal, rotating the three-dimensional items around the perimeter causing the selected item be displayed as a new focus item.”

In fact, Kojima disparages the use of a pointing device as recited in independent claim 1. In the Background of Kojima, the use of a pointing device and corresponding cursor are

repeatedly indicated as being undesirable in three-dimensional environments. *See, e.g., Kojima*, col. 2, lines 14-50. For instance, Kojima indicates that in three-dimensional applications: “selectable icons may not easily be . . . selected;” “it becomes difficult . . . to position a cursor on an area of a selectable icon by using a mouse;” “icons . . . are difficult to designate by a cursor and are too small to be easily distinguished;” and “[i]t is difficult to correctly position a cursor over a particular one among a large number of such three-dimensional icons by using a conventional mouse.” *Id.* Accordingly, Kojima is specifically directed to providing a solution for selecting icons in a three-dimensional environment that employs a media selection device having a rotary disc type knob so that positioning a cursor over an icon is not required. For instance, Kojima states that an icon may be selected with “no need of positioning a cursor over the icon on the screen. *See, id.*, col. 3, lines 12-13; col. 10, lines 48-49.

As such, it is respectfully submitted that Kojima fails to describe, either expressly or inherently, each and every element of independent claim 1, as amended herein, and, as such, claim 1 is not anticipated by Kojima. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b). Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 2-5 and 9-10 depend directly or indirectly from independent claim 1. As such, Applicants respectfully submit that claims 2-5 and 9-10 are patentable over Kojima for at least the above-cited reasons and request withdrawal of the 35 U.S.C. § 102(b) rejections of these claims as well.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design

community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections based on Kojima and MacPhail

Claims 6, 7, and 12-25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima in view of U.S. Patent No. 6,661,434 to MacPhail (“MacPhail”). As Kojima and MacPhail, either alone or in combination, fail to teach or suggest all the claim limitations of each claim, Applicants respectfully traverse this rejection, as hereinafter set forth.

Referring initially to claims 6, 7, and 12, these claims depend from independent claim 1 and, as such, are patentable over Kojima for at least the reasons cited above. MacPhail fails to cure the deficiencies of Kojima with respect to its failure to teach or suggest multiple limitations of the base claim 1. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claims 6, 7, and 12.

Independent claim 13, as amended herein, is directed one or more computer-storage media embodying a computerized system for organizing and displaying information to a user. The claim recites features similar to those recited in independent claim 1. For instance, claim 13 includes “a rotation control module for rotating the three-dimensional items around the perimeter upon receiving an item selection signal indicative of a user selection of a selected item from the one or more additional items by a user positioning a cursor over the selected item using a pointing device, wherein the selected item becomes a new focus item.” As such, it is respectfully submitted that claim 13 is patentable over Kojima fails for at least the reasons cited above for claim 1. Additionally, MacPhail fails to cure the deficiencies of Kojima with respect

to its failure to teach or suggest multiple limitations of claim 13. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 13 under 35 U.S.C. § 103(a). Claim 13 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 14-19 and 21-25 depend from independent claim 13, and, as such, are patentable over Kojima and MacPhail for at least the reasons cited above. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claims 14-25.

C. Rejections based on Kojima and Beier

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kojima in view of U.S. Patent Application Publication No. 2003/0227453 (“Beier”). As Kojima and Beier, either alone or in combination, fail to teach or suggest all the claim limitations of claim 11, Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 11 depends from independent claim 1 and, as such, is patentable over Kojima for at least the reasons cited above. Beier fails to cure the deficiencies of Kojima with respect to its failure to teach or suggest multiple limitations of the base claim 1. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claim 11.

CONCLUSION

For the reasons stated above, claims 1-7, 9-19, and 21-25 are now in condition for allowance. Applicant(s respectfully request withdrawal of the pending rejections and allowance of claims 1-7, 9-19, and 21-25. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 19-2112.

Respectfully submitted,

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